

AMENDMENT

U.S. Appln. No. 09/886,223

REMARKS

On page 1 of the Office Action, the Examiner acknowledges Applicant's claim to priority, but indicates that the certified copies of the priority documents have not been received.

Applicant will shortly file a certified copy of each of the Norwegian priority applications.

On page 2 of the Office Action, the Examiner acknowledges Applicant's election of the invention of Group I, i.e., Claims 26-47 and 57-60, without traverse, and the cancellation of non-elected Claims 48-56 and 61-64.

In paragraph 3, on page 2 of the Office Action, the Examiner objects to Claim 28 as being an improper dependent claim.

For the following reasons, Applicant respectfully traverses the Examiner's objection.

The Examiner is requested to note that Claim 26 sets forth that the magnifying tags correspond to:

(a) one or more nucleotide bases of the adapter binding region or

(b) one or more nucleotide bases in proximity to the adapter binding region or

(c) one or more nucleotide bases which overlap the adapter binding region.

Claim 28 therefore properly limits the method of Claim 26 to the first alternative, i.e., wherein the magnifying tags correspond to one or more bases of the adapter binding region.

In paragraph 5, on page 3 of the Office Action, the Examiner rejects Claims 26-47 and 57-60 under 35 U.S.C. § 112, second paragraph.

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Specifically, the Examiner states that it is unclear what is intended by the phrase "correspond to", i.e., does such mean that one or more bases must be complimentary to (i.e., able to hybridize) to the magnifying tags. Further, the Examiner objects to the phrase "in proximity to"?

The magnifying tags are not complementary to the nucleotide bases of the adaptor binding region. Pages 12-13 of the specification defines "corresponding" and describe how the magnifying tags are intended to indicate the presence of a particular nucleotide base and are representative of that base. It is the adaptor molecule (which comprises the magnifying tags) that is complementary to one or more nucleotide bases of the adaptor binding region (see Fig. 3A). The magnifying tags are used as a means to produce a signal that can be detected and characterized to determine the corresponding nucleotide base of the adaptor binding region. Thus, Applicants respectfully traverse this aspect of the Examiner's rejection.

In any event, Applicant also amends the claims to recite "nucleotide" bases for purposes of clarity, and since recently U.S. Examiners have been requiring such language, and made some additional minor clarifying amendments.

As to the expression "in proximity to", the Examiner is requested to note that in step (E), the adapter molecule binds to a region adjacent to a region of the target molecule, or a region which overlaps with the region of the target molecule to which an adapter in the previous cycle binds. Thus, Applicant hereby to amends step (A) of Claim 26 to recite the adjacent and overlapping alternatives, instead of "in proximity to".

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Accordingly, Applicant respectfully submit that the claims clearly and definitely recite the invention of interest, and thus requests withdrawal of the Examiner's rejection.

In paragraph 7, on page 4 of the Office Action, the Examiner rejects Claims 57-58 under 35 U.S.C. § 102(e) as being anticipated by Brenner et al (2000).

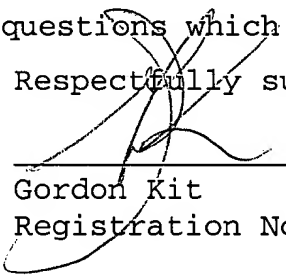
Similarly, in paragraph 8, on page 4 of the Office Action, the Examiner rejects Claim 57 under 35 U.S.C. § 102(b) as being anticipated by Brenner (1996).

Applicant hereby cancel Claims 57-58 without prejudice, thereby rendering moot the Examiner's rejections.

In view of the amendments to the claims and the arguments set forth above, reexamination, reconsideration, and allowance are requested.

The Examiner is invited to contact the undersigned at his Washington telephone number on any questions which might arise.

Respectfully submitted,



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